REMARKS

Applicant's invention addresses a problem of responding to user inquiries based on a review of the content of a web site by providing preliminary information on the web pages that were visited by the user making the inquiry. More specifically, the present invention relates to an electronic catalog, such as an online product catalog. (Spec., Page 1, Lines 4-9). Typically, to respond to a user inquiry, a person (responder) is frequently forced to make a response with only general information, since it is difficult for the responder to determine how much knowledge the user has on a product being inquired about. (Spec., Page 2, Lines 1-9). This creates a need for follow-up inquiries if too little information is provided to the user, or creates extra work for the responder if information, already known to the user, is again provided. (Spec., Page 15, Lines 2-16).

As can be appreciated the labor cost of responding to user inquiries can be expensive. Applicant's invention provides both time and cost savings in a very cost conscious industry.

> "Thus when differences that may appear technologically minor nonetheless have a practical impact, particularly in a crowded field, the decision-maker must consider the obviousness of the new structure in this light."
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> *Continental Can Co. USA Inc. v. Monsanto Co.*, 20 U.S.P.Q. 2d. 1746, 1752 (Fed. Cir. 1991).

Applicant's invention provides time and cost savings by transmitting a user's browsing history along with a user's inquiry for display on a terminal of the responder. (Spec., Page 3, Lines 14-20). The responder can make an intelligent assumption as to how much knowledge the user has about a product by determining if the user has visited a web page for that particular product (product page). If the user has not visited the product page, the responder can provide a

generalized response, including a request that the user visit the product page to obtain additional information. If the user has already visited the product page, the responder can provide a more specific response, including providing detailed information which may not be found on the product page but at other unvisited web pages. (Spec., Page 15, Lines 2-16).

The Office Action rejected Claims 1-4 as being unpatentable over *Fushimi et al.* (US Publication 2004/0148232) in view of *Hanai et al.* (US Publication 2001/0051893).

Fushimi et al. discloses an electronic catalog aggregation apparatus which facilitates the distribution of electronic catalogs from various catalog providers through a common system. (*Fushimi et al.*, Abstract). The goal of *Fushimi et al.* is to provide an electronic catalog system which aggregates multiple electronic catalogs from different providers, and to provide a common accounting operation for all of the electronic catalogs. *Fushimi et al.* can be used in a website which simply links to different electronic catalogs, and where the website owner makes sales commissions from catalog owners for sales generated from the website. (*See Fushimi et al.*, Para. 0008). This is a common type of commerce website that uses content pages to encourage visits and offer products directed to the type of visitors that would view the website, e.g. travel information on points of interest and airline tickets and hotel accommodations for points of interest.

With respect to Claim 1, *Fushimi et al.* does not disclose "a first providing unit configured to provide hierarchically arranged web pages to a browser terminal via a network, the web pages including an inquiry page for entering an inquiry and content pages." The Office Action asserts that *Fushimi et al.* discloses an inquiry page for entering an inquiry and content pages other than the inquiry page by referring to Para. 0127. (Office Action, Page 3). *Fushimi et al.* discloses a catalog aggregator which searches a catalog for missing information. When

missing information is detected, the content provider is contacted to provide this missing information. (*Fushimi et al.*, Para. 0127). The <u>catalog aggregator makes a request</u> to the content provider to provide missing information. (*Fushimi et al.*, Para. 0127). The catalog aggregator of *Fushimi et al.* is a system that has a data collection and receiving unit, and not an actual user. (*Fushimi et al.*, Para. 0084). In contrast, Applicant's system allows <u>a user to make an inquiry through an inquiry page</u> and allows a responder to respond to that inquiry with background information specific to the user displayed to the responder. (Spec., Page. 2, Lines 12-15).

Fushimi et al. also does not disclose "a recording unit configured to record therein a history of the provision of content pages to the browser terminal." The Office Action asserts that *Fushimi et al.* discloses a recording unit operable to record therein a history of the provision of content pages to the browser terminal by referring to Para. 0012.j However, *Fushimi et al.* only discloses computer readable program code for causing a computer to function as an electronic catalog aggregation apparatus. (*Fushimi et al.*, Para. 0012). *Fushimi et al.* does not disclose a recording unit or any means of recording a user's browsing history. In contrast, Applicant's system comprises a recording unit configured to record the history of content pages viewed by a user through a browser terminal. (Spec., Page 11, Lines 18-20).

Furthermore, *Fushimi et al.* does not disclose "a receiving unit configured to receive an inquiry entered into the inquiry page via the browser terminal." The Office Action asserts that *Fushimi et al.* discloses a receiving unit operable to receive an inquiry entered into the inquiry page via the browser terminal by referring to Para. 0084 and Figure 3, Element 33. (Office Action, Page 3). *Fushimi et al.* discloses a receiving unit to collect catalog data from catalog providers using a file transfer protocol (FTP) server. (*Fushimi et al.*, Para. 0082). The catalog data is not sent to the receiving unit via an inquiry page on a browser terminal, but rather through

a network connection using a FTP client. The FTP client is not a browser, and does not include an inquiry page. In contrast, Applicant's receiving unit receives information sent to it from an inquiry page, where the inquiry page is a web page which a user accesses through a browser terminal, such as a web browser. (Spec., Page 2, Lines 16-20).

Lastly, *Fushimi et al.* does not disclose "a judging unit configured to judge, when the inquiry is received, whether any content page of a predetermined hierarchical level has been provided to the browser terminal, based on the history" or "a second providing unit configured to provide the received inquiry and a result of the judgment to a responder terminal used by a responder for responding to the inquiry, the responder terminal being different from the browser terminal." The Office Action concedes that *Fushimi et al.* does not disclose a judging unit. (Office Action, Page 3).

The Office Action cites the *Hanai et al.* patent publication to supplement the deficiencies in the *Fushimi et al.* disclosure.

Hanai et al. discloses a system and a method for recommending related items to users in an online shopping system. (*Hanai et al.*, Para. 0002). The goal of *Hanai et al.* is to identify items a user has already purchased, or is currently attempting to purchase, and to automatically present related accessories and items to a user. *Hanai et al.* can be used in an e-commerce website where a user logs in and is presented with suggested items which may be of interest, based on the user's previous purchases on the website.

Hanai et al. does not disclose "a first providing unit configured to provide hierarchically arranged web pages to a browser terminal via a network, the web pages including an inquiry page for entering an inquiry and content pages." *Hanai et al.* does not provide an inquiry page to users. Instead, *Hanai et al.* discloses a <u>log-in screen</u> where users input individual identification

information such as a log-in name, a password, and a corporation ID for authentication processing. (*Hanai et al.*, Para. 0084-5). In contrast, Applicant's system allows <u>a user to make an inquiry through an inquiry page</u> that requires a response from a responder. (Spec., Page. 2, Lines 12-15).

Next, *Hanai et al.* does not disclose "a recording unit configured to record therein a history of the provision of content pages to the browser terminal." *Hanai et al.* discloses an item recommending system comprising a <u>sales history</u> storing memory which stores sales history information representative of items that are sold together. (*Hanai et al.*, Claim 2). In contrast, Applicant's system comprises a recording unit configured to record a <u>history of content pages viewed by a user through a browser terminal</u>. (Spec., Page 11, Lines 18-20).

Furthermore, *Hanai et al.* does not disclose "a receiving unit configured to receive an inquiry entered into the inquiry page via the browser terminal." The receiver of *Hanai et al.* does not receive an inquiry which is sent to a responder. *Hanai et al.* discloses a receiver which receives <u>log-in information</u>, and transmits it to a specifier to extract the user information from a client database. (*Hanai et al.*, Claim 15). In contrast, Applicant's receiving unit receives an <u>inquiry</u> sent to it from an inquiry page, where the inquiry requires a response from a responder. (Spec., Page. 2, Lines 12-15).

Additionally, *Hanai et al.* does not disclose "a judging unit configured to judge, when the inquiry is received, whether any content page of a predetermined hierarchical level has been provided to the browser terminal, based on the history." The Office Action asserts that *Hanai et al.* discloses a judging unit operable to judge whether a predetermined content page has been provided to the browser terminal, based on the history, by referring to Para. 0103. (Office Action, Pages 3-4). *Hanai et al.* discloses a management server which checks the <u>sales history</u>

of a user within a fixed period of time, and extracts the item sold to the user. The system then judges a user's <u>sales history</u> in order to determine which items a user <u>already possesses</u>, and to recommend related items to the user. (*Hanai et al.*, Para. 0102-3). In contrast, Applicant's system has a judging unit which reviews the <u>browsing history</u> of a user to determine if a user has visited a particular product page. If so, the responder is notified that the product page has been viewed by the user. (Spec., Page 8, Lines 8-11; Figure 5).

Finally, *Hanai et al.* does not disclose "a second providing unit configured to provide the received inquiry and a result of the judgment to a responder terminal used by a responder for responding to the inquiry, the responder terminal being different from the browser terminal." The Office Action asserts that *Hanai et al.* discloses a providing unit operable to provide the received inquiry and a result of the judgment to a responder for responding to the inquiry by referring to Para. 0103. (Office Action, Page 4). A responder terminal is not disclosed in *Hanai et al.* In contrast, Applicant's system comprises a responder terminal where a responder can view a user inquiry and browsing history, and provide a response to the user's inquiry. (Spec., Page 2, Lines 12-15; Figure 10).

Even, if hypothetically, the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992).

> [T]he level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these deciders from using their own insight or, worse yet, hindsight, to gauge obviousness. Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment. Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. *Al Site Corp. v. VSI*

> *International, Inc.*, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999) (citations omitted).

The Federal Circuit has addressed this issue in the case of *In re Rouffet*, 47 U.S.P.Q.2d 1453, 149 F.3d 1350 (Fed. Cir. 1998). In *Rouffet*, the Court noted that virtually all inventions are combinations of old elements. It concluded that:

> an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' *Id.* at 1357.

The Court pointed to the absence of any teaching in the cited references for making the proposed modifications, and found that the Board had reversibly erred in determining that the invention was rendered obvious because there was no identification of motivation to choose the selected feature.

Applicants respectfully traverse this combination since it is believed to be unobvious to combine the technology of *Fushimi et al.* and the technology of *Hanai et al.* because *Fushimi et al.* merely discloses a common technique of aggregating electronic catalogs, while *Hanai et al.* discloses an e-commerce website which recommends items to users based on previous purchases on that website, not in response to inquiries for information from the user. A hypothetical combination of these two references would result in an online shopping system consisting of multiple vendors which recommends items to users based on previous purchases. Any such hypothetical combination would not address the first and second providing unit, recording unit,

receiving unit, and judging unit of Claim 1. Claim 1 further distinguishes this hypothetical combination by having a responder terminal being different from the browser terminal.

With respect to Claim 2, *Fushimi et al.* does not disclose "a checking unit configured to check, each time a content page is provided to the browser terminal, whether the content page is of the predetermined hierarchical level." *Fushimi et al.* discloses a company credit information existence checking unit for checking whether the company credit information exists in the company credit information database or not. (*Fushimi et al.*, Para. 0275). In contrast, Applicant's checking unit <u>checks the attribute on a product page</u> to determine the hierarchical level of the content page that a user visits. (Spec., Page 16, Lines 9-16).

Hanai et al. does not disclose "a checking unit configured to check, each time a content page is provided to the browser terminal, whether the content page is of the predetermined hierarchical level." The Office Action contends that *Hanai et al.* discloses the checking unit of Claim 2 by referring to Para. 0102. (Office Action, Page 4). *Hanai et al.* discloses a management server that <u>checks the sales history</u> of a user. The sales history information is used to determine related items to recommend to the user. (Hanai et al, Para. 0102). In contrast, Applicant's checking unit <u>checks the attribute on a product page</u> to determine the hierarchical level of the content page that a user visits. (Spec., Page 16, Lines 9-16).

With respect to Claim 3, all arguments for patentability with respect to Claim 1 are repeated and incorporated herein.

Newly added Claim 11 describes an inquiry processing apparatus comprising "a specifying unit configured to specify which of the content pages has an inquiry button clicked to call the inquiry page on which the inquiry received by the receiving unit is entered." Applicant's specifying unit lists the content page that the user clicks the inquiry button from for the

responder. (Spec., Page 18, Lines 8-13). Neither *Fushimi et al.* nor *Hanai et al.*, alone or in combination, disclose a specifying unit listing the content page the user clicks the inquiry button from for the responder.

Newly added Claim 13 describes an inquiry processing method comprising "a specifying step configured to specify which of the content pages has an inquiry button clicked to call the inquiry page on which the inquiry received by the receiving unit is entered." With respect to Claim 13, all arguments for patentability with respect to Claim 11 are repeated and incorporated herein.
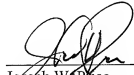
Claim 2 and newly added Claims 5-10 depend from Claim 1, and newly added Claim 12 depends from Claim 11. The dependent claims add features that more particularly define the invention and further distinguish over the cited references and prior art of record.

In view of the above comments, it is believed that the present case is now in condition for allowance and early notification of the same is requested.

If there are any questions with regards to this matter, the undersigned attorney would appreciate a telephone conference.

Very truly yours,

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